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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/398,665	09/17/1999	KARL L. GINTER	7451.0005-01	1372
22852	7590	09/09/2004	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			DARROW, JUSTIN T	
			ART UNIT	PAPER NUMBER
			2132	

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/398,665	GINTER ET AL.	
	Examiner	Art Unit	
	Justin T. Darrow	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 121-140 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 121-140 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 September 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>19</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

1. Claims 1-140 have been presented for examination. Claims 1-20 have been canceled and new claims 21-117 have been added in a preliminary amendment filed 09/17/1999. Claims 21-117 have been canceled and new claims 118-120 have been added in an amendment filed 02/27/2002. Claims 118-120 have been canceled and new claims 121-140 have been added in an amendment filed 07/28/2003. Claims 121-140 have been examined.

Priority

2. Acknowledgment is made that the instant application is a continuation of Application No. 08/699,712, filed 08/12/1996, now abandoned, which is a continuation-in-part of Application No. 08/388,107, filed 02/13/1995, now abandoned.

Drawings

3. The drawings filed on 09/17/1999 are acceptable subject to correction of the informalities indicated on the "Notice of Draftperson's Patent Drawing Review," PTO-948, attached to a previous Office action, Paper No. 18. Formal drawings with corrections must be made in reply to this Office action. See 37 CFR 1.85(a).

Response to Arguments

1. Applicant's arguments filed 04/06/2004 have been fully considered but they are not persuasive.
2. As per independent claims 121 and 134, Stefik does teach:

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using a digital certificate associated with a user (see column 8, lines 1-7; figure 2, item 202; a digital work has a condition requiring an authorization in the form of a digital certificate, subjected to fees and usage rights, possessed by the user to gain access to the digital work) to select between two or more alternative conditions for governing the use of electronic content (see column 18, lines 11-22; a PRINT right to make 5 copies for \$10.00 and a PRINT right to make unlimited copies for \$100.00, where a purchaser may choose which option best fits his needs; see column 31, lines 15-21; figure 18, step 1801; general tests are performed before a right associated with a transaction can be exercised such as install, uninstall, and delete rights that may be implemented requiring a requester to have an authorization certificate before the right can be exercised). Stefik points out in these cited passages that the authorization certificate allows the user to select a condition to use a particular right, such as install, uninstall, and delete rights, by possession of an authorization certificate for the particular right. Additionally, the user can satisfy a particular condition to use a right to a certain degree, such as a print right to make five or unlimited copies.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless—

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 121-123, 125-129, and 134-140 are rejected under 35 U.S.C. 102(e) as being anticipated by Stefik, U.S. Patent No. 5,715,403 A.

As per claim 121 and 134, Stefik illustrates a rights-management method and computer program product comprising:

receiving, at a first computer system, a request from a user to access electronic content, associated with it two or more alternative conditions for governing the use of the electronic content (see column 36, lines 48-53; sending a server a message to initiate a play transaction indicating the work to be played; see column 19, lines 47-58; figure 15, item 1504; where "Render-Code: = [Play:{Player:Player-ID}[Print:{Printer:Printer-ID}]]" lists rights all involving making various copies of the digital work);

using at least one digital certificate associated with the user (see column 8, lines 1-7; figure 2, item 202; a digital work has a condition requiring an authorization in the form of a digital certificate, subjected to fees and usage rights, possessed by the user to gain access to the digital work) to select one of the conditions (see column 18, lines 11-22; a PRINT right to make

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5 copies for \$10.00 and a PRINT right to make unlimited copies for \$100.00, where a purchaser may choose which option best fits his needs; see column 31, lines 15-21; figure 18, step 1801; general tests are performed before a right associated with a transaction can be exercised such as install, uninstall, and delete rights that may be implemented requiring a requester to have an authorization certificate before the right can be exercised);

satisfying the condition (see column 31, lines 25-35; figure 18, steps 1803 and 1804; when the required test of an authorization certificate is passed and the digital work has been granted the requested right); and

granting the user access to the electronic content (see column 32, lines 31-32; figure 18, step 1816; the right specific steps are now performed; column 36, lines 60-63; the server provides the data as requested to the requester and the requester plays the work contents on the player).

As per claims 122 and 135, Stefik further points out:

that the two or more alternative conditions include alternative requirements that payment information be sent to a second computer system before granting access (see column 32, lines 21-28; figure 18, steps 1815 and 1805; checking fee conditions for the right with the initiation of various financial transactions between the repository and associated credit server including metering of usage before the right is exercised; see column 24, lines 17-22; figure 15, item 1519; with several kinds of fee specifications).

As per claim 123, Stefik then mentions:

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a specification of two or more alternative payment mechanisms (see column 24, lines 33-41; figure 15, items 1520 and 1521; simple fee to be paid every time the right is exercised or a metered-rate fee paid according to how long the right is exercised).

As per claims 125 and 136, Stefik also specifies:

that the first condition comprises a first price for accessing the electronic content (see column 25, lines 56-63; work can be played for one cent per minute with a minimum of 25 cents in any day that it is used); and

that the second condition comprises a second price for accessing the electronic content (see column 25, lines 51-55; work can be printed for a fee of \$1).

As per claims 126 and 137, Stefik moreover explains:

that the first condition indicates a first class of users authorized to access the electronic content upon payment of the first price, and that the second condition indicates a second class of users authorized to access the electronic content upon payment of the second price (see column 15, lines 47-52; creators intend their works to be available only to security levels higher than a particular level; see column 31, lines 4046; figure 18, step 1807; checking a security condition to determine if the requester is at a specified security class; see column 32, lines 21-24; figure 18, step 1805; checking the fee conditions for the right for that class).

As per claims 127 and 139, Stefik next mentions:

That a first condition indicates a first class of users authorized to access the electronic content upon satisfaction of the first condition, and a second condition indicates a second class of users authorized to access the electronic content upon satisfaction of the second condition (see column 15, lines 47-52; creators intend their works to be available only to security levels higher than a particular level; see column 31, lines 4046; figure 18, step 1807; checking a security condition to determine if the requester is at a specified security class; see column 32, lines 21-24).

As per claim 128, Stefik then describes:

using at least one digital certificate associated with the user to select at least one of the conditions comprises examining a first digital certificate to determine whether the user belongs to the first or second class of users (see column 31, lines 40-46; figure 18, step 1807; checking security and access conditions to determine if the requester is at the specified security class; see column 31, lines 18-21; figure 18, step 1801; by an authorization certificate; see column 16, lines 8-38; TABLE 2; Security Levels 2-6 and 10; a digital certificate is provided for identification at the security level).

As per claims 129 and 140, Stefik also mentions:

examining at least a first digital certificate (see column 28, lines 8-17; figure 16, steps 1605, 1606, 1607, and 1608; after decrypting the identification certificate and extracting the repository identifier, the repository identifier is checked against a "hotlist" of comprised document repositories) and a second digital certificate to determine whether the user belongs to the first

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class of users (see column 31, lines 40-46; figure 18, step 1807; checking security and access conditions to determine if the requester is at the specified security class; see column 31, lines 18-21; figure 18, step 1801; by an authorization certificate; see column 16, lines 8-38; TABLE 2; Security Levels 2-6 and 10; a digital certificate is provided for identification at the security level)

As per claim 138, Stefik discusses:

that the first condition identifies a first clearinghouse for accepting payment for access to the electronic content (see column 29, lines 60-66; when conditions are satisfied and a usage fee is required for granting the request, a billing transaction occurs between the repository and the credit server acting as a clearinghouse); and

that the second condition identifies a second clearinghouse for accepting payment for access to the electronic content (see column 29, lines 60-66; when conditions are satisfied and a usage fee is required for granting the request, a billing transaction occurs between the repository and a clearinghouse indirectly through a credit server).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claim 124 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik, U.S. Patent No. 5,715,403 A as applied to claim 123 above, and further in view of Dolphin, U.S. Patent No. 5,457,746 A.

Stefik discloses the rights-management method of claim 123. However, he does not explicitly teach a subscription payment mechanism.

Dolphin describes a payment mechanism (see column 5, lines 57-60; “one time buy” attribute where information is purchased once) comprising a subscription (see column 12, lines 53-61; figure 16, columns 106, 107, and 108; “Subscriber One” with a six month subscription obtains a key for the first month which is updated for subsequent months).

Therefore, it would have been obvious to one of ordinary skill in the computer art at the time the invention was made to combine the method of Stefik with the subscription payment mechanism of Dolphin to allow the publisher to provide subscription service starting at different times and having different lengths, without providing access to more data than the authorized service (see column 13, lines 9-14).

7. Claim 130 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik, U.S. Patent No. 5,715,403 A as applied to claim 127 above, and further in view of Weiss, U.S. Patent No. 5,237,614 A.

Stefik discloses the rights-management method of claim 127. However, he does not explicitly teach a class of users in a department of an organization.

Weiss describes:

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a first class of users comprises members of a first department in an organization (see column 10, lines 13-17; depending on the user's security level in the company), and

a second class of users comprises members of a second department in an organization (see column 10, lines 13-17; depending on the user's group, in the company, that needs to know).

Therefore, it would have been obvious to one of ordinary skill in the computer art at the time the invention was made to combine the method of Stefik with departments in an organization of Weiss to grant access to the user to certain files on a server (see column 10, lines 13-17).

8. Claim s 131-133 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik, U.S. Patent No. 5,715,403 A as applied to claim 121 above, and further in view of Rose, Jr., U.S. Patent No. 5,521,815 A.

Stefik discloses the rights-management method of claim 121. However, he does not explicitly teach a tax that must be paid to a government entity.

Rose, Jr. illustrates:

indication that must be paid to a first and second government entity upon purchase of access to the electronic content by a member of the first and second class of users (see column 15, lines 63-67; column 16, lines 1-13; figure 1H, step 226; municipal/state/federal taxes, sales taxes, excise taxes that must be paid depending the kind of vehicle and special registration status (i.e. handicapped, government office, etc.); see column 8, lines 55-61; figures 1A-1H; for a motor vehicle owner's purchase of registration for the motor vehicle in electronic form).

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Therefore, it would have been obvious to one of ordinary skill in the computer art at the time the invention was made to combine the method of Stefik with government taxes of Rose, Jr. for a uniform system for tracking titles on items of value from the point of sale device (see column 1, lines 28-38).

As per claim 132, Rose, Jr. further discloses:

sending payment information to a second computer system including authorization to debit an account by an amount sufficient to pay the first tax (see column 16, lines 14-16; figure 1G, step 254; funds are dispersed electronically to all of the proper entities from the secured account).

Therefore, it would have been obvious to one of ordinary skill in the computer art at the time the invention was made to combine the method of Stefik with the sending of payment information of Rose, Jr. for a uniform system for tracking titles on items of value from the point of sale device (see column 1, lines 28-38).

As per claim 133, Rose, Jr. additionally describes:

The second computer system receiving payment information (see column 16, lines 14-16; figure 1G, step 254; funds are dispersed electronically to all of the proper entities from the secured account) and sending the first tax to the first government entity (see column 15, lines 63-67; column 16, lines 1-13; figure 1H, step 226; municipal/state/federal taxes, sales taxes, excise taxes that must be paid) and a payment to the author and distributor of the electronic content (see column 16, lines 4-13; figure 1H, step 226; registration fee to the DMV).

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Therefore, it would have been obvious to one of ordinary skill in the computer art at the time the invention was made to combine the method of Stefik with the receiving payment information, the sending the first tax to the first government entity and a payment to the author and distributor of the electronic content of Rose, Jr. to distribute all documents and payments to the proper owners (see column 16, lines 24-25).

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephone Inquiry Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin T. Darrow whose telephone number is (703) 305-3872 until mid October 2004, then (571) 272-3801 thereafter, and whose electronic mail address is

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justin.darrow@uspto.gov. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barrón, Jr., can be reached at (703) 305-1830 until mid October 2004, then (571) 272-3799.

The fax number for Formal or Official faxes to Technology Center 2100 is (703) 872-9306. In order for a formal paper transmitted by fax to be entered into the application file, the paper and/or fax cover sheet must be signed by a representative for the applicant. Faxed formal papers for application file entry, such as amendments adding claims, extensions of time, and statutory disclaimers for which fees must be charged before entry, must be transmitted with an authorization to charge a deposit account to cover such fees. It is also recommended that the cover sheet for the fax of a formal paper have printed "**OFFICIAL FAX**". Formal papers transmitted by fax usually require three business days for entry into the application file and consideration by the examiner. Formal or Official faxes including amendments after final rejection (37 CFR 1.116) should be submitted to (703) 872-9306 for expedited entry into the application file. It is further recommended that the cover sheet for the fax containing an amendment after final rejection have printed not only "**OFFICIAL FAX**" but also "**AMENDMENT AFTER FINAL**".

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900 until mid October 2004, then (571) 272-2100 thereafter.

September 7, 2004



**JUSTIN T. DARROW
PRIMARY EXAMINER
TECHNOLOGY CENTER 2100**